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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sound International, Inc.

Serial No. 76337681

Lex Mathis of Sound Law Group PLLC for Sound International,
Inc.

David H. Stine, Trademark Examining Attorney, Law Office
114 (Margaret Le, Managing Attorney).

Before Hairston, Holtzman and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark BOSTON HARBOR for goods identified in the
application as "oscillating portable fans, stand fans,
table fans, wall fans, ceiling fans, electric household and
portable fans."¹

¹ Application Serial No. 76337681, filed on November 15, 2001,
which is based on an allegation of a bona fide intention to use
the mark in commerce. The word "BOSTON" has been disclaimed
apart from the mark as shown.

Applicant has appealed the trademark examining attorney's refusal to register applicant's mark. The refusal was made under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark BOSTON, previously registered for "fans,"² as to be likely to cause confusion.

The appeal has been fully briefed, but applicant did not request an oral hearing. We affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods

² Registration No. 1,911,191 issued August 15, 1995 under Section 2(f) of the Act; renewed. Although the registration covers other goods, the refusal is based on "fans."

and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to a consideration of the respective goods. We agree with the examining attorney that the goods must be considered to be legally identical. The cited registration lists "fans" and this term encompasses the applicant's more specifically identified "oscillating portable fans, stand fans, table fans, wall fans, ceiling fans, electric household and portable fans."

Applicant maintains that it currently sells ceiling mounted fans whereas registrant sells fans that rest on surfaces. Further, applicant argues that its goods "are marketed and sold exclusively through Orgill Worldwide Sourcing to independent hardware stores and home improvement stores", whereas registrant's goods "are sold in office supply stores." (Brief, p. 10). In support of these arguments, applicant submitted the declarations of its president and its attorney's legal assistant who spoke with a representative of registrant.

It is well-settled that the question of likelihood of confusion must be determined based on an analysis of the goods identified in applicant's application vis-à-vis the goods identified in the cited registration, rather than

what the evidence shows the goods actually are. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1992). Thus, in this case, we must assume that applicant will use its mark on all the fans listed in its application and we must assume that registrant uses its mark on all kinds of fans, including the fans listed in applicant's application. Moreover, in the absence of specific limitations in applicant's and registrant's respective identifications, we must assume that the products set forth therein are sold in all normal channels of trade for goods of that type. Thus, for purposes of determining whether confusion is likely, the trade channels also must be considered the same.

This brings us to a consideration of the marks. As our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, applicant seeks to register BOSTON HARBOR, while the cited mark is BOSTON. Obviously, because applicant's mark consists of one of the words of the cited mark, there are consequent similarities

in appearance and pronunciation. Applicant argues that the fact that both marks contain the word BOSTON is not a sufficient basis for finding likelihood of confusion, pointing out that there are over fifty third-party registrations of marks that include the word BOSTON. Applicant submitted with its brief a printout from the Patent and Trademark Office's TESS database which lists marks that include the word "Boston".³

As pointed out by the examining attorney, third-party registrations are entitled to little weight on the question of likelihood of confusion. See *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and the existence on the register of arguably similar marks cannot aid an applicant in its effort to register another mark which so resembles a

³ Under Trademark Rule 2.142(d), evidence submitted for the first time with a brief on the case is normally considered by the Board to be untimely and therefore would usually be given no consideration. Moreover, in order to make third-party registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the Patent and Trademark Office's own database generally must be submitted. However, we note that where, as here, the examining attorney has not only failed to object to the evidence, but has discussed it in his brief, the Board will treat the evidence as being of record.

registered mark as to be likely to cause confusion. See AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Furthermore, the evidence furnished by applicant is of very limited probative value because it consists simply of marks listed by registration number, and thus it fails to indicate the particular goods in connection with which the marks are registered.

In any event, "Boston" obviously is a geographic term. The term, as used in both marks, has the same geographic significance, and the additional word HARBOR in applicant's mark does not change that meaning or the commercial impression of the marks.

Under actual marketing conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Dassler KG v. Roller Derby Skate Corp., 206 USPQ 255 (TTAB 1980).

In this case, the addition of the word HARBOR does not serve to distinguish the marks. Purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally

retains a general, rather than a specific, impression of trademarks encountered in the marketplace. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir. 1992).

Two additional arguments made by applicant require comment. Applicant argues that its product packaging is different from that of registrant and submitted photographs to illustrate this. However, the issue of likelihood of confusion must be determined by comparing applicant's mark as it appears in the application and the cited mark as it appears in the registration. We cannot consider either applicant's or registrant's product packaging because such packaging is not part of the marks in the application and the cited registration. Moreover, applicant and registrant are free to change their respective product packages at any time. Thus, for purposes of determining likelihood of confusion, any differences in product packaging are irrelevant. See *Kimberly-Clark Corp. v. H. Douglas Enterprises*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); and *The Quaker Oats Company v. Acme Feed Mills, Inc.*, 192 USPQ 653 (TTAB 1976).

Further, we note that at page 9 of its brief, applicant states that it is willing to restrict its identification of goods to "ceiling mounted fans" to avoid a likelihood of confusion. Apart from the fact that such an offer to restrict the identification of goods is untimely, it would not serve to obviate the likelihood of confusion because registrant's broadly identified fans encompass ceiling mounted fans.

We conclude that in view of the substantial similarity in the commercial impressions of applicant's mark BOSTON HARBOR and registrant's mark BOSTON, their contemporaneous use on the legally identical goods involved in this case would be likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.